

I. AMENDMENT

Please make the following amendment:

In the Claims:

Please cancel claims 62-66 without prejudice.

1. (Twice Amended) A pointing device comprising:

- B1
sub
C1*
- an interface for operably communicating with an electronic system;
 - a position sensor, responsive to user movement thereof, for conveying positional information by way of said interface to the electronic system;
 - a user-depressable button for conveying selection information by way of said interface to the electronic system;
 - a biometric sensor disposed at a location such that when operating said pointing device in a normal manner a user's hand rests naturally in a position to place a finger of the user's hand in proximity to and readable by said biometric sensor; and
 - a verification system for operably communicating with the electronic system, the verification system comprising a user storage, an authorization profile storage, and an audit log storage, the audit log storage being configured to store:
 - (a) user identification information from said biometric sensor in response to a denial of access to said electronic system; and
 - (b) user identification information from said biometric sensor and (attempted transaction information) in response to a denial of access to perform a specific transaction within said electronic system.

61. (Amended) A pointing device comprising:

- B2
sub
C2*
- an interface for operably communicating with an electronic system;
 - a position sensor, responsive to user movement thereof, for conveying positional information by way of said interface to the electronic system;
 - a user-depressable button for conveying selection information by way of said interface to the electronic system; and

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a biometric sensor disposed at a location such that when operating said pointing device in a normal manner a user's foot rests naturally in a position to place a toe of the user's foot in proximity to and readable by said biometric sensor; and
a verification system for operably communicating with the electronic system, the verification system comprising a user storage, an authorization profile storage, and an audit log storage, the audit log storage being configured to store:

- (a) user identification information from said biometric sensor in response to a denial of access to said electronic system; and
- (b) user identification information from said biometric sensor and attempted transaction information in response to a denial of access to perform a specific transaction within said electronic system.

67. (Amended) A computer verification system for use with a biometric sensor, said verification system comprising:

BB

a processor coupled to the biometric sensor; and

a memory coupled to the processor, the memory comprising:

a user storage and an authorization profile being configured to verify an identification of a user each time the user inputs a request to an electronic system; and

an audit log storage being configured to store:

- (a) user identification information from the biometric sensor in response to a denial of access to the electronic system; and
 - (b) user identification information from said biometric sensor and attempted transaction information in response to a denial of access to perform a specific transaction within said electronic system.
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71. (Amended) A method for verifying a user of an electronic system coupled to a biometric sensor, the method comprising:

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obtaining user identification information of the user with the biometric sensor;

obtaining a selection of the user for the electronic system;

comparing the user identification information with information stored in a user storage;

79/ comparing the selection with authorization information stored in an authorization profile; determining if the user is authorized to perform the selection; and storing identification information and attempted transaction information of the user in the audit log storage if the user is denied access to perform the selection within the electronic system.

79. (Amended) A verification system for operably communicating with an electronic system, the verification system comprising a user storage, an authorization profile storage, and an audit log storage, the audit log storage being configured to store information in response to a successful transaction attempt and grant of access with said electronic system and to a denial of access to said electronic system and denials of access to perform specific actions within said electronic system.

II. RESPONSE TO OFFICE ACTION DATED 3/37/01

A. Status of the claims

Claims 1, 2, 7-24, and 49-81 were pending prior to the office action dated April 11, 2001. Claims 62-66 have been cancelled without prejudice to be pursued in one or more continuing applications. Independent claims 1, 61, 67, 71, and 79 have been amended for clarification. Appendix A shows the substance of those amendments. Support for the amendments may be found throughout the specification. No new matter has been added. Claims 1, 2, 7-24, 49-61, and 67-81 are now pending. For the Examiner's convenience, the pending claims are attached at Appendix B.

B. Restriction requirement

Applicant affirms the election, without traverse, to prosecute the Group I claims (claims 1, 2, 7-24, 49-61, and 67-81). The non-elected claims of Group II (claims 62-66) have been canceled without prejudice so that they may be pursued in one or more continuing applications.

C. *Summary of Argument*

All the pending claims are allowable for several, independent reasons. None of the cited art, taken alone or in combination, discloses or suggests the recited authorization profile storage. Independent from this reason, none of the cited art, taken alone or in combination, discloses or suggests the recited audit log storage. Moreover, none of the cited art discloses or suggests the combination of these two features nor provides any motivation to come to that combination.

D. *Matchett in view of Bogosian (or further in view of Automatic Teller Machines) does not render the claims unpatentable*

Claims 1, 2, 10, 11-14, 49-56 and 60 stand rejected as being obvious under 35 U.S.C. § 103 in view of Matchett combined with Bogosian. Applicant respectfully traverses.

1. *Neither Matchett nor Bogosian disclose or suggest the authorization profile*

Independent claim 1 recites a verification system including an authorization profile. As explained in the specification (e.g., pages 14-15), an authorization profile may be used in certain embodiments to define, for example, permissible dates, times, and functions that a specific person can perform within a specific electronic system. Such a feature is nowhere disclosed or even suggested by Matchett or Bogosian (taken alone or in combination). In fact, the Examiner never even contends that Matchett or Bogosian contains the recited authorization profile. Correspondingly, Applicant respectfully contends that the cited art is clearly insufficient to support this rejection and asks for its withdrawal.

2. *Automatic Teller Machines do not disclose or suggest the authorization profile*

The Examiner mentions the authorization profile element of the claim at page 6 (bottom) through page 7 of the present office action. There, the Examiner appears to argue (without support) that information printed on a receipt of an Automatic Teller Machine (such as time information and deposit information) is equivalent to the recited authorization profile storage.

Such an assertion is simply wrong.. Worse, this exact rejection was previously lodged (and then withdrawn) by the Examiner following extensive arguments presented by the Applicant. The Applicant has already spent considerable time and resources explaining why Automatic Teller Machines are not material to the patentability of the present invention. To emphasize the plight of the Applicant in this regard, a brief history of the prosecution of this case before the Examiner is set forth immediately below (dates prior to 5/30/00 refer to the parent application, which is S/N 08/940,553):

1/25/99	Office action — based primarily on Matchett;
6/25/99	Response;
8/31/99	Final office action — based primarily on Matchett plus official notice that Automatic Teller Machines include features of the claims;
11/30/99	Response plus notice of appeal — arguments presented why Automatic Teller Machines were not material and why the rejection by “official notice” was improper;
12/21/99	Advisory action — used Kadono and Granzow references to support Automatic Teller Machine arguments and to remove Applicant’s objection regarding the previous, improper “official notice” rejection;
1/31/00	Request for CPA plus preliminary amendment — arguments presented why Kadono and Granzow (and Automatic Teller Machines) did not render claims unpatentable;
2/29/00	Office action — Automatic Teller Machine argument is withdrawn; rejections now based on Matchett and Lemelson;
5/30/00	Request for continuation plus preliminary amendment — arguments presented against Matchett and Lemelson;
4/11/01	Present office action — identical arguments about the Automatic Teller Machine return; rejections now based primarily on Matchett and Bogosian.

To address this latest (albeit identical) use of the Automatic Teller Machine argument, Applicant incorporates by reference its responses dated 11/30/99 and 1/31/00. These responses are

attached to this communication at Tabs 1 and 2 respectively. To summarize, Automatic Teller Machines do not disclose or even remotely suggest the claimed authorization profile storage. Applicants respectfully request the Examiner to remove this rejection for at least the reasons it was removed previously. If the Office insists on again maintaining this same Automatic Teller Machine argument, Applicant requests a citation to a prior-art reference or an affidavit from the Examiner in support of the rejection. See M.P.E.P. § 2144.03.

3. *Neither Matchett nor Bogosian discloses or suggests the audit log*

Independent claim 1 has been amended to clarify the recited audit log storage. Amended claim 1 clarifies that the audit log storage stores the following:

- (a) user identification information from said biometric sensor in response to a denial of access to said electronic system; and
- (b) user identification information from said biometric sensor and attempted transaction information in response to a denial of access to perform a specific transaction within said electronic system.

Such features are nowhere disclosed or even suggested by Matchett or Bogosian (taken alone or in combination).

In contrast, Bogosian is directed to a system for verifying the use of a credit or identification card, in which “access” to the card is totally granted (allowing the user to use the card without restriction) or totally denied (confiscating the card from the user). Abstract. In particular, the disclosure of Bogosian involves several sequential verification steps:

- (1) scan information from the magnetic tape of the card and compare it to corresponding information in a database — if there is not a match, confiscate the card prior to use;
- (2) scan the surface of the card (to check for tampering) and compare it to corresponding information in a database — if there is not a match, confiscate the card prior to use;

- (3) take a fingerprint of the *user* of the card and compare it to the *owner's* fingerprint information printed on the card and the owner's fingerprint information in a database — if there is no match, confiscate the card prior to use and record the fingerprint of the user;
- (4) perform additional verification measures (such as voice, retina), if necessary.

Bogosian, FIG. 1; col. 2, lines 17-63; col. 5, lines 24-34.

Bogosian does not disclose or even suggest storing user identification information (e.g., a fingerprint) and attempted transaction information in response to a denial of access to perform a specific transaction within an electronic system, as recited in claim 1. The only time Bogosian stores a user's fingerprint is when the card is confiscated (and, hence, the card cannot even be used to attempt a transaction). Bogosian *never* stores a fingerprint along with attempted transaction information because Bogosian does not allow *any* transaction to be attempted within a system once the fingerprint is taken. In this regard, Bogosian actually teaches away from the recited audit log by suggesting that fingerprint information should only be taken prior to confiscating a user's means to effect *any* transaction.

A simple, non-limiting example illustrates the shortcomings of Bogosian and its stark differences with the recited features of claim 1. A user practicing an embodiment of the invention of claim 1 may use a computer mouse to attempt to buy an item for \$5 from the internet by clicking on a button labeled "purchase item - \$5." The invention of claim 1 may check the user's fingerprint against an authorization profile to determine if this particular user is allowed to make such a purchase (such a feature, as described above, is totally absent from Bogosian). If so, the transaction can proceed and an audit log entry may be created. For the sake of example, assume the transaction is allowed, and the user makes her purchase; an audit log entry may show that this particular user made a \$5 purchase.

Now, the same user clicks on a button labeled “purchase item - \$1000.” The invention of claim 1 may again check the fingerprint against the authorization profile, but this time it may determine that the user is not allowed to make such an expensive purchase. Access is correspondingly denied to perform this one specific transaction within the system, and the invention stores the user’s fingerprint along with her attempted transaction information (*i.e.*, the audit log makes an entry saying that this particular person with this particular fingerprint attempted to buy something for \$1000 but was denied).

Such features are nowhere disclosed or even suggested by the cited art. Bogosian simply discloses that if a user’s fingerprint does not match an owner’s fingerprint, a credit card should be confiscated prior to any use, and the user’s fingerprint should be stored. Again, Bogosian does not disclose or suggest storing user identification information and attempted transaction information in response to a denial of access to perform a specific transaction within an electronic system. Because the cited art does not teach or suggest the recited features of the audit log storage, Applicants respectfully submit that claim 1 and all claims depending therefrom are in condition for allowance. Removal of the current rejection is correspondingly requested.

4. *Automatic Teller Machines do not disclose or suggest the audit log*

On page 6 (bottom) through page 7 of the present office action, the Examiner argues that Automatic Teller Machines also include an audit log. Applicant traverses and refers the Examiner to the communications incorporated by reference above. *See* attached Tabs 1 and 2. In sum, Automatic Teller machines do not disclose or even remotely suggest the recited audit log storage. For instance, the Examiner has identified no Automatic Teller Machine prior art (even in combination with Matchett or another similar reference) having the ability to store:

- (a) user identification information from said biometric sensor in response to a denial of access to said electronic system; and

- (b) user identification information from said biometric sensor and attempted transaction information in response to a denial of access to perform a specific transaction within said electronic system.

E. Matchett in view of Bogosian and Applicant's disclosure does not render the claims unpatentable

Claims 7-9, 20, and 21, rejected by the Examiner as being unpatentable over Matchett in view of Bogosian and further in view of "Applicant's prior art," should be allowed for at least the reasons stated above regarding claim 1, from which claims 7-9, 20, and 21 are dependent.

F. Matchett in view of Bogosian and Bidiville does not render the claims unpatentable

Claims 15-19, rejected by the Examiner as being unpatentable over Matchett in view of Bogosian and further in view of Bidiville, should be allowed for at least the reasons stated above regarding claim 1, from which claims 15-19 are dependent.

G. Matchett in view of Bogosian and O'Connor does not render the claims unpatentable

Claims 22-24, rejected by the Examiner as being unpatentable over Matchett in view of Bogosian and further in view of O'Connor., should be allowed for at least the reasons stated above regarding claim 1, from which claims 22-24 are dependent.

H. Matchett in view of Bogosian and Axelrod does not render the claims unpatentable

Claims 57 and 58, rejected by the Examiner as being unpatentable over Matchett in view of Bogosian and further in view of Axelrod, should be allowed for at least the reasons stated above regarding claim 1, from which claims 57 and 58 are dependent.

I. Claims 61 and 67-81 are patentable as well

Claims 61 and 67-81 stand rejected in a manner analogous to the rejections of claims 1-24. Office action, page 12. Independent claims 61, 67, 71 and 79 are allowable for at least the reasons presented in relation to claim 1. In particular, none of the cited art, taken alone or in

combination, teach or suggest the recited authorization profile storage and audit log storage. Accordingly, those claims and the claims depending therefrom are in condition for allowance.

III. PETITION FOR EXTENSION OF TIME

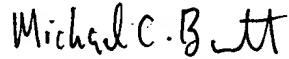
Pursuant to 37 C.F.R. § 1.136(a), Applicant petitions for an extension of time of three months up to and including October 11, 2001 in which to respond to the office action dated April 11, 2001. Pursuant to 37 C.F.R. § 1.17, a check in the amount of \$460.00 is enclosed, which is the process fee for a three-month extension of time. If the check is inadvertently omitted, or should any additional fees under 37 C.F.R. §§ 1.16 to 1.21 be required for any reason relating to the enclosed materials, or should an overpayment be included herein, the Office is authorized to deduct or credit fees from or to Fulbright & Jaworski Deposit Account No.: 50-1212/10026193/MCB.

CONCLUSION

Applicant believes that the foregoing remarks fully respond to all outstanding matters for this application. Applicant respectfully requests that the rejections of the claims be withdrawn so that this application may swiftly pass to issuance.

Should the Examiner desire to sustain any of the rejections discussed in relation to this paper, Applicant requests a telephone conference between the Examiner, the Examiner's supervisor, and the undersigned attorney at 512-536-3018.

Respectfully submitted,



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